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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,677	02/10/2004	Jonathan J. Oliver	PA3630US	3791
22830	7590	06/23/2008		
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			EXAMINER LEE, PHILIP C	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 06/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,677

Applicant(s)

OLIVER ET AL.

Examiner

PHILIP C. LEE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 3/17/05, 7/31/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-11 and 13-36 in the reply filed on February 15, 2008 is acknowledged.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on March 17, 2005 and July 31, 2006 were in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

Objection

3. Claims 1-11 and 13-36 are objected to because of the following informalities or grammar errors: claims 1 (line 6), 35 (line 10) and 36 (line 6), "the associated domain and IP address" should be "the domain associated and the IP address". Claims 26 (line 2) and 27 (line 2), "IP address and domain" should be "the IP address and the domain".

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the boundary domain.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 and 13-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following terms lack proper antecedent basis:

- i. the domain – claims 35 and 36;
- ii. the same domain – claim 4;
- iii. the stated sender domain – claim 14;
- iv. the boundary domain – claim 15;
- v. the IP address and domain classification - claims 28 and 29.

- b. Claim language in the following claims is not clearly understood:

- vi. As per claims 1 (line 4), 35 (line 8), and 36 (line 4) it is unclear what is "its" referring to.
- vii. As per claim 3, line 2, the scope and metes and bounds are indefinite. Since the phrase "not commonly associated" is editorial, it is unclear what is considered as uncommon.
- viii. As per claim 13, line 2, it is unclear what is being determined in claim 9 (i.e., no determination in claimed in claim 9).

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ix. As per claim 36, line 1, the scope and metes and bounds are indefinite. Since the phrase “*configured to*” is not a requirement that it is performed, therefore it renders limitations after the phrase “*configured to*” are to be moot.

Claim Rejections - 35 USC 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 36 is rejected under 35 U.S.C. 101 because “A system” including a classifier (i.e., software) does not include any functional hardware structure of a system. An system (i.e., machine) comprising software is considered as program per se, which is not one of the categories of statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3-5, 7-8, 10, 14-15, 17-18 and 30-36 are rejected under 35

U.S.C. 102(c) as being anticipated by US Patent Application Publication 2004/0068542 to Lalonde et al (hereinafter Lalonde).

10. As per claims 1 and 35, Lalonde teaches determining the domain from which the message is purported to be sent (Fig. 6; [0040]); determining an IP address from which the message was relayed at some point in its transmission (Fig. 6; [0040]); associating the domain with the IP address (Fig. 6; [0031] and [0040]); and classifying the message based on the associated domain and IP address ([0039] and [0040]).

11. As per claim 36, Lalonde teaches a system for classifying a message, including a classifier configured to: determining the domain from which the message is purported to be sent (Fig. 6, [0040]); determining an IP address from which the message was relayed at some point in its transmission (Fig. 6; [0040]); associating the domain with the IP address (Fig. 6; [0031] and [0040]); and classifying the message based on the associated domain and IP address ([0039] and [0040]).

12. As per claim 3, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes determining that the IP address is not commonly associated with the domain ([0040]) (i.e., not match).

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13. As per claim 4, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes checking classifications of other messages associated with the same domain (i.e., checking the blacklist) ([0042]) and different IP addresses ([0039]).

14. As per claim 5, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein a plurality of IP addresses is associated with the domain ([0039]).

15. As per claim 7, Lalonde discloses the invention as claimed in claim 1 above. Lalonde further teach wherein the IP address is a boundary IP address (72, 62, fig. 2) (the IP address must be one or more hops away from a gateway).

16. As per claim 8, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein the IP address is preconfigured ([0039]).

17. As per claim 10, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein the IP address is learned ([0039]) (learned from the DNS).

18. As per claim 14, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein the domain is the stated sender domain ([0040]) (e.g. hotmail.com).

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19. As per claim 15, Lalonde teaches the invention as claimed in claim 1 above.

Lalonde further teach wherein the domain is the boundary domain (50, 60, 70, fig. 2) (domains must be one or more hops away from gateway).

20. As per claims 17 and 18, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes forming a score based on previous classifications made to the IP address and domain pair ([0038]).

21. As per claim 30, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes classifying the message based on the IP address ([0039]).

22. As per claim 31, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes classifying the message based on the domain ([0038]).

23. As per claim 32, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes classifying the message based on the domain and determining that the message was forged ([0038]).

24. As per claim 33, Lalonde teaches the invention as claimed in claim 1 above. Lalonde further teach wherein classifying includes determining a score for the IP address ([0038]).

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25. As per claim 34, Lalonde teaches the invention as claimed in claim 1 above.

Lalonde further teach wherein classifying includes determining a score for the domain ([0038]).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 9 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde.

28. As per claims 9 and 13, Lalonde teaches the invention as claimed in claim 1 above. Although Lalonde teaches wherein the IP address is preconfigured ([0039]), however, Lalonde does not specifically teaches including wherein the IP address is preconfigured to be one hop from a gateway IP address. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include IP address preconfigured to be one hop or any hop from a gateway IP address because by doing so it would increase the user control by allowing configuration according to the user's design choice.

29. Claims 2, 6, 11, 16 and 19-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde as applied to claim 1 above, and further in view of Murray et al, U.S. Patent 7,366761 (hereinafter Murray).

30. As per claim 2, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach overriding a white list. Murray teaches overriding a white list based on the classification (col. 18, lines 38-40).

31. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of overriding a white list based on the classification would increase the effectiveness of Lalonde's system by filtering unwanted e-mails based on sender information.

32. As per claim 6, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach the IP address is associated with the domain. Murray teaches wherein the IP address is associated with the domain (col. 7, line 65-col. 8, line 4).

33. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of the IP address is associated with the domain would increase the effectiveness of Lalonde's system by allowing identification of the IP address is

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associated with the domain in order to filter unwanted e-mails based on sender information.

34. As per claim 11, Lalonde teaches the invention as described in claim 1 above. Lalonde does not teach including the IP address is adaptively determined. Murray teaches wherein the IP address is adaptively determined (col.3, lines 25-27).

35. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of the IP address is adaptively determined would increase the effectiveness of Lalonde's system by allowing determination of the IP address in order to filter unwanted e-mails based on sender information.

36. As per claim 16, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach consulting a white list. Murray teaches wherein classifying includes consulting a white list (col. 4, line 66-col. 5, line 6).

37. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of consulting a white list would increase the effectiveness of Lalonde's system by allowing identification of the e-mails in order to classify wanted or unwanted e-mails based on sender information.

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38. As per claim 19, Lalonde teaches the invention as claimed in claim 1 above.

Lalonde does not teach determining a spam ratio. Murray teaches wherein classifying includes determining a spam ratio (col. 9, lines 8-13).

39. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of determining a spam ratio would increase the effectiveness of Lalonde's system by allowing identification of unwanted e-mails based on spam ratio.

40. As per claim 20, Lalonde teaches the invention as claimed in claim 1 above.

Lalonde does not specifically teach a spam rate. Murray teaches wherein classifying includes determining a spam rate (col. 10, lines 53-65).

41. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of determining a spam rate would increase the effectiveness of Lalonde's system by allowing identification of unwanted e-mails based on spam rate.

42. As per claim 21, Lalonde teaches the invention as claimed in claim 1 above.

Lalonde does not specifically teach a spam rate. Murray teaches wherein classifying includes determining an estimated instantaneous spam rate (col. 10, lines 53-65; col. 11, lines 24-27).

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43. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of determining a spam rate would increase the effectiveness of Lalonde's system by allowing identification of unwanted e-mails based on spam rate.

44. As per claim 22, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach decaying a classification variable with time. Murray teaches wherein classifying includes decaying a classification variable with time (col. 3, lines 30-35).

45. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of decaying a classification variable with time would increase the alertness of Lalonde's system by allowing identification of unwanted e-mails based on sender's reputation.

46. As per claim 23, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach giving a classification weight relative to another classification. Murray teaches wherein classifying includes giving a classification greater weight relative to another classification (col. 9, lines 20-31).

47. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because

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Murray's teaching of giving a classification greater weight relative to another classification would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on sender's reputation.

48. As per claim 24, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach giving a classification weight relative to a computer classification. Murray teaches wherein classifying includes giving a user classification greater weight relative to a computer classification (col. 8, lines 44-50; col. 9, lines 20-31).

49. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of giving a classification greater weight relative to a computer classification would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on complied sender's reputation.

50. As per claim 25, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not teach giving weight of a good classification. Murray teaches wherein classifying includes giving an indeterminate classification a fraction of the weight of a good classification (col. 9, lines 20-31).

51. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because

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Murray's teaching of giving weight to a good classification would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on sender's good reputation.

52. As per claims 26 and 27, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not specifically teach consulting a table indexed by IP address and domain. Murray teaches wherein classifying includes consulting a table indexed by IP address and domain wherein each cell includes information about previous classifications (col. 9, lines 32-40).

53. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of consulting a table of IP address and domain would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on sender's information.

54. As per claim 28, Lalonde teaches the invention as claimed in claim 1 above. Lalonde does not specifically teach providing the IP address and domain classification as input to another classifier. Murray teaches providing the IP address and domain classification (col. 8, lines 20-24) as input to another classifier (col. 8, line 31-46; col. 9, lines 20-31).

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55. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Murray because Murray's teaching of providing the IP address and domain classification as input to another classifier would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on sender's information.

56. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde as applied to claim 1 above, and further in view of Appleman, U.S. Patent Application Publication 2005/0076240 (hereinafter Appleman).

57. As per claim 29, teaches the invention as claimed in claim 1 above. Although Lalonde teaches providing the IP address and domain classification as input ([0038] and [0039]), however, Lalonde does not specifically teach a Bayesian classifier. Appleman teach providing the IP address and domain classification as input to a Bayesian classifier ([0058]).

58. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Lalonde and Appleman because Appleman's teaching of providing the IP address and domain classification as input to a Bayesian classifier would increase the effectiveness of Lalonde's system by allowing unwanted e-mails to be accurately identified based on sender's information.

Conclusion

59. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sobel et al, US Patent 7,366,919.

60. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip C Lee/

Patent Examiner, Art Unit 2152

